

DISCUSSION OF THE AMENDMENT

Due to the length of the specification herein, Applicants will cite to the paragraph number of the published patent application (PG Pub) of the present application, i.e., US 2006/0166844, when discussing the application description, both in this section and in the Remarks section, *infra*, rather than to page and line of the specification as filed.

Claim 1 has been amended by incorporating the subject matter of Claims 5 and 6 therein, except that the “preferably . . .” language of Claim 6 has been omitted. Claims 5 and 6 have been canceled.

New Claims 10-19 have been added. Claims 10-12 are supported by Claim 6. Claims 13 and 14 are supported by Claim 1. Claim 15 is supported in the specification at paragraph [0014]. Claim 16 is supported in the specification at paragraph [0016]. Claim 17 is supported in the specification at paragraph [0017]. Claim 18 is supported in the specification at paragraph [0018]. Claim 19 is supported by Claim 9. Claim 9 has been canceled.

No new matter is believed to have been added by the above amendment. Claims 1-4, 7, 8 and 10-19 are now pending in the application.

REMARKS

The rejection of Claims 1-9 under 35 U.S.C. § 103(a) as unpatentable over US 4,790,957 (Mach et al), is respectfully traversed. Mach et al relates to aliphatic or aromatic polycarboxylic acid esters of formula I therein useful as base oils alone in lubricating oil compositions in or admixture with completely synthetic, partially synthetic, or mineral oil-based lubricant compositions (column 2, lines 22-38). The Examiner finds that Mach et al discloses, in effect, the ether compound recited in Claim 6.

In reply, the ether compound of Claim 6, and now of amended Claim 1, having formula (1) therein, is mutually exclusive of the polycarboxylic acid ester of Mach et al. Thus, the presently-claimed invention is patentable over Mach et al for that reason alone. In addition, the Examiner finds that Mach et al does not disclose an aniline point of 60°C or higher, but finds that it would have been obvious over Mach et al. However, Comparative Example 1 herein, which employs di(2-ethylhexyl) sebacate as a base oil, which compound is a carboxylate, analogous to the carboxylate esters of Mach et al, is shown in the specification herein in Table 1 to have an aniline point of -20°C or lower. Thus, while Applicants do not submit that all carboxylate esters have aniline points below 60°C, this comparative example shows that one cannot simply presume inherency or obviousness without evidence in support thereof.

Lubricating oil compositions based on a carboxylic acid ester compound as the base oil are known to have low viscosity and exhibit low evaporation loss. However, these compositions have high polarity and have adverse effects on organic materials, such as inducing swelling. For example, when such a composition is used in an engine oil, problematic swelling of the sealing material and other materials made of rubber can occur. When the composition is used in an oil for hydraulic bearings or oilless bearings, plastic

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materials can be adversely affected. In addition, such ester-based oil compositions have poor solubility with respect to additives, and are thus problematical for this reason also.

The present invention successfully addresses these problems and realizes a reduction of evaporation loss despite being of low viscosity and having excellent compatibility with organic materials.

For all the above reasons, it is respectfully requested that this rejection be withdrawn.

The rejection of Claim 6 under 35 U.S.C. § 112, second paragraph, is respectfully traversed. Indeed, the rejection is now moot in view of the above-discussed amendment. Accordingly, it is respectfully requested that the rejection be withdrawn.

All of the presently-pending claims in this application are now believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Respectfully submitted,

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